

REMARKS

I. Introduction

With the cancellation herein without prejudice of claim 29, claims 14 to 28 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

II. Allowable Subject Matter

Applicant notes with appreciation the indication of allowable subject matter included in claim 16.

In this regard, the Examiner will note that claim 16 has been rewritten herein in independent form, except for the feature of the hollow opening configured in size to guide a device for marking a surface of the medium. It is believed and respectfully submitted that claim 16 is in condition for immediate allowance.

III. Allowed Claims 26 and 27

Applicant notes with appreciation the indication that claims 26 and 27 are allowed. The feature of *the hollow opening configured in size to guide a device for marking a surface of the medium* has been cancelled herein without prejudice from claims 26 and 27. No new matter has been added.

IV. Rejection of Claims 14, 15, 18 to 20, 23, 24 and 28 Under 35 U.S.C. § 103(a)

Claims 14, 15, 18 to 20, 23, 24 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent No. 3,662,255 ("Garrett") and U.S. Patent No. 5,325,873 ("Hirschi"). For at least the following reasons, Applicant respectfully submits that the combination of Garrett and Hirschi does not render unpatentable these claims.

As an initial matter, the feature of *the hollow opening configured in size to guide a device for marking a surface of the medium* has been cancelled herein without prejudice from claims 14 and 28.

Claim 14 relates to a hand-held locating device for detecting an object enclosed in a medium, which includes *inter alia*, a hollow opening, and has been amended to recite that the opening is a single hollow opening. Support for this amendment may be found, for example, in Figs. 1 and 2.

Garrett does not disclose, or even suggest, a locating device having a single hollow opening. The Examiner on page 8 states that according to Garrett, “between outer loop item 32 containing the inductive coil, the internal web,¹⁸ and the inner loop 32, **there are four hollow openings.**” Thus, nowhere does Garrett disclose, for example, the feature that the at least one **sensor system** surrounds the **single** hollow opening. Instead, the sensor system of Garrett surrounds **four** openings, not a **single** hollow opening as in the present claim. Hirschi does not cure this deficiency of Garrett.

It is therefore respectfully submitted that the combination of Garrett and Hirschi does not render unpatentable claim 15, 18 to 20, 23, and 24, which depend from claim 14.

Claim 28, as amended, include subject matter analogous to that of claim 14. It is therefore respectfully submitted that the combination of Garrett and Hirschi does not render unpatentable claim 28 for at least the same reasons set forth above in support of the patentability of claim 14.

Withdrawal of the present rejection is therefore respectfully requested.

V. Rejection of Claim 17 Under 35 U.S.C. § 103(a)

Claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Garrett and U.S. Patent No. 4,859,931 (“Yamashita”). For at least the following reasons, Applicant respectfully submits that the combination of Garrett and Yamashita does not render unpatentable claim 17.

Claim 17 depends from claim 14 and therefore incorporates all of the features of claim 14. For at least the reasons set forth above with respect to claim 14, Garrett does not disclose, or even suggest, all of the features of claim 14. Yamashita does not cure the critical deficiencies set forth above. As such, the combination of Garrett and Yamashita does not disclose or suggest all of the features of independent claim 14 or dependent claim 17, and therefore does not render unpatentable the presently pending claim.

Withdrawal of the present rejection is therefore respectfully requested

VI. Rejection of Claims 21 and 22 Under 35 U.S.C. § 103(a)

Claims 21 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Garrett in view of U.S. Patent No. 6,266,006 (“Audet”). For at least the following reasons, Applicant respectfully submits that the combination of Garrett and Audet does not render unpatentable claims 21 and 22.

Claims 21 and 22 depend from claim 14 and therefore incorporate all of the features of claim 14. For at least the reasons set forth above with respect to claim 14, Garrett does not disclose, or even suggest, all of the features of claim 14. Audet does not cure the critical deficiencies set forth above. As such, the combination of Garrett and Audet does not disclose or suggest all of the features of independent claim 14 or dependent claims 21 and 22, and therefore does not render unpatentable the presently pending claims.

Withdrawal of the present rejection is therefore respectfully requested.

VII. Rejection of Claim 25 Under 35 U.S.C. § 103(a)

Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Garrett and U.S. Patent No. 6,844,713 (“Steber”). For at least the following reasons, Applicant respectfully submits that the combination of Garrett and Steber does not render unpatentable claim 25.

Claim 25 depends from claim 14 and therefore incorporates all of the features of claim 14. For at least the reasons set forth above with respect to claim 14, Garrett does not disclose, or even suggest, all of the features of claim 14. Steber does not cure the critical deficiencies set forth above. As such, the combination of Garrett and Steber does not disclose or suggest all of the features of independent claim 14 or dependent claim 25 and therefore does not render unpatentable the presently pending claim.

Withdrawal of the present rejection is therefore respectfully requested.

VIII. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Date: December 22, 2010 By: /Clifford A. Ulrich/
Clifford A. Ulrich, Reg. No. 42,194 for:
Gerard A. Messina, Reg. No. 35,952

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646